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DAE #

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PATENT

Attorney Docket # 2132-48PCON



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Mariette LEHTO

Serial No.: 09/903,225

Filed: July 11, 2001

For: Method and System for the Effecting Payments
by Means of a Mobile Station

Examiner: Not Yet Assigned

Group Art: 2681

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OCT 10 2002

OFFICE OF PETITIONS

Assistant Commissioner for Patents
Washington, DC 20231
Attn: Box Petitions

REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 CFR §1.47(b)

SIR:

This Request for Reconsideration of Petition is being submitted in response to the Decision Refusing Status under 37 C.F.R. §1.47(b) (the "Decision") which was mailed from the U.S. Patent and Trademark Office on July 5, 2002. That Decision, which refused applicant's request in the Petition filed March 27, 2002 that the Patent and Trademark Office accept the filing of the above-captioned application by Sonera Oyj, the party having proprietary interest, *in lieu* of by non-signing sole inventor Mariette Lehto, provided applicant with a term of two (2) months from July 5, 2002 to correct certain deficiencies in the original Petition as identified by the Petitions Examiner in the Decision.

Applicant hereby requests a one-month extension of that two-month term, and encloses herewith a check in the amount of \$110.00 in payment of the government fee required for the one-month extension of time hereby sought. Any additional fees or charges

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required at this time in connection with this Request for Reconsideration may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

In the Decision, the Petitions Examiner identified certain defects in the Declaration of Anni Vepsäläinen which was submitted with the Petition to demonstrate the refusal of the non-signing inventor, Mariette Lehto, to execute the application papers. In response, applicant submits herewith, as Exhibit 1 to this Request for Reconsideration of Petition, an Affidavit of Mika Valkeapää, an employee of the party, Sonera Oyj, having proprietary interest in the subject patent application.

In the attached Exhibit 1 Affidavit, Mr. Valkeapää states that, as a result of reorganizations in Sonera Oyj, he became responsible for the patent matters that were previously the responsibility of Ms. Vepsäläinen, and that he is currently overseeing the subject U.S. patent application. Mr. Valkeapää further states that on or about July, 2001 he prepared a Declaration for the subject U.S. patent application, and then delivered the Declaration to inventor Mariette Lehto for signature, together with a complete copy of the application. He additionally states that no signed Declaration has however been received from Mariette Lehto.

Mr. Valkeapää has also attached to his Affidavit a copy of a letter that Mr. Valkeapää first sent to Mariette Lehto on September 3, 2001. (An English-language translation of that letter, which has been signed by the translator, is also attached to the Exhibit 1 Valkeapää Affidavit.) The letter additionally carries thereon numerous handwritten contemporaneous notes from Mr. Valkeapää concerning additional efforts that he made to contact and communicate with Mariette Lehto in connection with the subject U.S. patent application. Among those handwritten notes are those from a telephone conversation with Ms. Lehto in which Ms. Lehto stated that she was "unwilling to cooperate". Thus, the attached Exhibit 1 Affidavit of Mika Valkeapää and the

appended copy of the Valkeapää letter to Ms. Lehto clearly indicates that a complete of the U.S. application, including a Declaration for signature, was mailed by Mr. Valkeapää to Mariette Lehto, that additional efforts to reach Ms. Lehto by telephone were made by Mr. Valkeapää, that no signed Declaration has been received from Ms. Lehto and, finally, that during at least one telephone conversation with Mr. Valkeapää the non-signed inventor Mariette Lehto stated her unwillingness to cooperate with Sonera in connection with the subject U.S. patent application. These facts provide a sufficient basis for concluding that sole inventor Mariette Lehto has refused to sign the subject patent application despite Sonera's good faith, *bona fide* efforts to obtain a signed Declaration from Ms. Lehto.

In the Decision, the Petitions Examiner also discussed certain deficiencies in the substitute application Declaration and Power of Attorney document (Exhibit 7 to the original Petition) which had been signed on behalf of the non-signing inventor by two representatives of Sonera Oyj, the party having proprietary interest in the subject U.S. patent application. Specifically, the Petitions Examiner indicated that she was unable to verify, via the Extract from the Trade Register (Exhibit 1 to the original Petition), whether the two signing individuals are in fact authorized to execute such a Declaration on behalf of Sonera Oyj. The Petitions Examiner further noted that the substitute Declaration lacked an indication of the date of execution.

Attached as Exhibit 2 hereto is a new application Declaration and Power of Attorney document which has been signed by the same two representatives of Sonera Oyj who signed the earlier-submitted document, namely Maire Laitinen and Tiia Tuovinen, respectively as General Counsel and Assistant General Counsel of Sonera Oyj. These two individuals are indeed listed, on the second page of the Extract from the Trade Register (Exhibit 1 to the original Petition) as being among those who are authorized to sign for the company so long as two of those listed individuals

each sign the document. To further assist the Petitions Examiner in this regard, a further copy of the Extract from the Trade Register - on which a right-facing arrow has been placed adjacent to the names of these two signing individuals, whose names have also been underscored on that further copy - is attached as Exhibit 3 hereto.

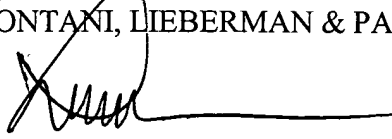
The Exhibit 2 Declaration and Power of Attorney document submitted herewith also indicates that it was executed on March 26, 2002.

In view of the contents of this Request for Reconsideration of Petition, and the accompanying submissions identified as Exhibits 1, 2 and 3 hereto, applicant respectfully requests that the Patent and Trademark Office reconsider and grant applicant's Petition (as originally filed on March 27, 2002 and as supplemented herewith) and thereby accept the filing of the subject U.S. patent application by Sonera Oyj *in lieu* of the non-signing sole inventor, Mariette Lehto, pursuant to 35 U.S.C. §118 and 37 C.F.R. §1.47(b).

The undersigned hereby declares that all statements made herein of his own knowledge are true, and that all statements made on information and belief are believed to be true; and, further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine, or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

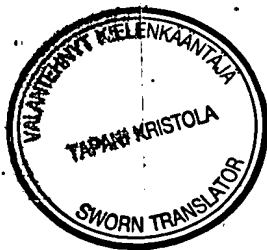
Respectfully submitted,
COHEN, PONTANI, LIEBERMAN & PAVANE

By



Lance J. Lieberman
Reg. No. 28,437
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

Dated: October 7, 2002



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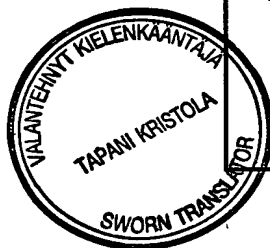
DECLARATION

THE UNDERSIGNED, Authorized Translator duly examined and by the Finnish Ministry of Justice admitted to certify translations made from the Finnish into the English language,

HEREBY solemnly declares that the attached document reading in English is a true and faithful translation of the attached letter reading in Finnish.

AND I MAKE this solemn declaration sincerely believing it to be true.

ON this 22nd day of May, 2002.



Tapani Kristola
Authorized Translator
Mäkikatu 48
26200 Rauma
Finland

sonera

1037US

Hello!

Could you please sign the attached transfer deeds and return them to the address below, so that we can get the patent documents ready ?

A transfer deed is used to authorize a patent agency to represent us in the official routines associated with the application.

Rewards are paid normally to the inventor even if he/she should no longer be employed by Sonera.

Regards Mika Valkeapää
Legal affairs, patents and trademarks
P.O. Box 106, Teollisuuskatu 15/6
00051 SONERA
tel. 020401
fax. 02040 63329
gsm 040-7041139
e-mail: mika.valkeapää@sonera.com

MESSAGE
LEFT
IN ANSWERING MACHINE

10.9

+ between the 10th and the 20th ??
13. or 14.9

20.9 Reached by phone in Sweden.
Unwilling to cooperate.

- has no telefax available
(or does not tell us)

- home address only

- no idea of payment of rewards
as .. does not know ..self

- does not know when
in Finland, Sweden, UK, ...

9
Letter dispatched on 24.10.
to Mariette, to the London
address



sonera

1037US

Hei!

Voisitko allekirjoittaa liitteenä olevat siirtokirjat ja palauttaa ne allaolevaan osoitteeseen, jotta saamme hakemuksen asiakirjat kuntoon?

Siirtokirjalla valtuutetaan patenttiasiamiestoimisto edustamaan meitä hakemukseen liittyvissä virastorutiineissa.

Palkkiot maksetaan normaalisti keksijälle, vaikka hän ei enää olisikaan työsuhteessa Soneraan.

Terv. Mika Valkeapää
Lakiasiat, patentit ja tavaramerkit
PL 106, Teollisuuskatu 15/6
00051 SONERA
tel. 020401
fax. 02040 63329
gsm 040-7041139
e-mail: mika.valkeapaa@sonera.com

JÄTETTY
Viestti
VASTAANAJAN

10.9

+ 10 & 20 p:n välissä ??
13 tai 14.9

20.9 Saatu langan
päähen Ruotsissa?
EI YHTIYSTUOHALUINEN

- ei fax - mahdollisuutta
(tai ei kero)
- kotios. ainoa
- palkkioiden maksusta
ei tietoa kun ei
itse tiedä
- ei tiedä koska
Suomesta, Ruotsissa,
UK:ssa, ...

kinje lähtenyt 24. ⁹
Marietalle Lontoon
osoitteeseen

**IN THE US PATENT AND TRADE-MARK OFFICE**

IN THE MATTER OF US 09/903,225 for the FI-990053, of 13 January 1999 METHOD AND SYSTEM FOR THE EFFECTING PAYMENTS BY MEANS OF A MOBILE STATION

AFFIDAVIT FOR THE ABOVE NOTED MATTER IN THE US PATENT AND TRADE MARK OFFICE

I, **Mika Valkeapää, of Sonera Oyj (formerly Sonera Oy), MAKE OATH AND SAY AS FOLLOWS:**

1. I am employed by Sonera Oyj (formerly Sonera Oy) of Helsinki, Finland. After re-arrangements on our company I have been addressed the patent matters of Ms. Vepsäläinen.
2. I am currently overseeing the matter of the registration of US patent application US 09/903,225 for us.
3. In 1999, Sonera Oyj (formerly Sonera Oy) filed a patent application FI 990053. The application was filed on 13 January 1999.
4. In 1999 Sonera Oyj (formerly Sonera Oy) filed an international application under the Patent Co-Operation Treaty (hereinafter "PCT") claiming the Finnish filing date as the priority date.
5. According to Finnish law, and more specifically, to the statute of the Laws of Employees Inventions, all inventions created during the time of an individual's employment with a company, are property of the employer. Ms. Lehto must execute all documents which are needed to ensure the subject invention is patented because she was an employee of Sonera Oy and helped create an invention at the time. Attached hereto is an assignment signed by Ms. Lehto of 16 September 1998. It serves as evidence to demonstrate the co-operation of Ms. Lehto prior to her decision not to execute documents needed for the subject patent. By that assignment she transferred her rights to the invention to Sonera Oy (currently Sonera Oyj).
6. According to the law and decree of employee inventions in Finland, Sonera Oyj has the rights to the invention in question and Ms. Lehto is obliged to sign all the documents needed in the patenting process with respect of the invention.
7. Again referring to the above mentioned assignment, Ms. Lehto, confirms that the rights to the subject invention, under the Finnish law belong to Sonera Oy and now its successor Sonera Oyj. By executing the patent document, she relinquishes her interests and rights to the invention.
8. Within 30 months of the priority date, 13 July 2001, the international application entered the national stage.
9. On or about July, 2001, I prepared declaration for the US national stage application. After completed, I delivered the declaration for signature together with a complete copy of application to Mariette Lehto and did not receive a signed declaration.

10. Enclosed is also my letter to Ms. Lehto that I sent her first time on 3 September 2001 and as I did not receive any answer I called her twice as evidenced by my notes in said letter. After these phone calls I sent this letter again to Ms. Lehto but this time to her London address. I still not have had any response to my correspondence to her.
11. As I have not received any signed declaration, I regard this as a refusal of signing a declaration.

HELSINKI 2002-10-03


Mika Valkeapää

NATIONAL BOARD OF PATENTS AND REGISTRATION OF FINLAND

EXTRACT FROM THE TRADE REGISTER

Trade name: Sonera Oyj

Business Identity Code: 1475607-9
Trade Register Number: 740.009
Company Registered: 30.06.1998
Company Form: public limited company
Domicile: Helsinki

Company's Contact Information:
Mailing Address: PL 106, 00051 Sonera
Visiting Address: Teollisuuskatu 15, 00510 Helsinki

Register entries:

TRADE NAME (registered 01.10.1999)
Sonera Oyj.

PARALLEL TRADE NAME (registered 01.10.1999)
(English) Sonera Corporation.

DOMICILE (registered 30.06.1998)
Helsinki.

BOARD OF DIRECTORS (registered 30.05.2001)

Chairman:

Tapio Jussi Anselmi Hintikka

Ordinary members:

Jorma Tapio Laakkonen

Eva Helena Maria Liljeblom

Jussi Eerikki Länsiö

Roger Ensio Talermo

Esa Erkki Tihilä

Tapio Johannes Vaahtokivi

Tom Wilhelm von Weymarn

Deputy members:

Kari Ilmari Vilkman

OTHER MANAGEMENT (registered 11.10.2001)

Managing Director:

Harri Eerik Koponen

Substitute for the Managing Director:

Aimo Eloholma

LEGAL REPRESENTATION (registered 03.07.1998)
Under the Companies Act, the Company's name is signed by the Board of Directors.

SIGNING ON BEHALF OF THE COMPANY (registered 21.09.1998)
According to the articles of association, the company's name is signed by the managing director on his own, and by two members of the board of directors together.

AUTHORIZATION TO SIGN FOR THE COMPANY (registered 05.09.2001)

Aimo Eloholma

Kim Juhani Ignatius

Jari Vesa Jaakkola

→ Maire Annikki Laitinen

Kirsti Helinä Lehtovaara-Kolu

Pekka Heikki Juhani Reijonen

Esko Juhani Rytönen

Leif Niklas Mikael Sonkin

Juha Pekka Varelius

Anni Kaarina Vepsäläinen

Persons authorized to sign for the company sign two together or each of them separately together with a member of the board.

PROCURATION RIGHTS (registered 12.11.2001)

Jari Juhani Kinnunen

Jukka Erkki Kämäri

Jukka Tapani Leinonen

Sirkka Anneli Marjakangas

Erkki Antero Oksanen

Tapani Mikael Pökkä

Lauri Pekka Takala

Jorma Leo Tukia

→ Tiia Silja Kristiina Tuovinen

The holders of procuration sign the company name two together or each of them separately together with a member of the board or with a person authorized to sign the company name.

TRADE NAME HISTORY:

01.10.1999 - Sonera Oyj

03.07.1998 - 30.09.1998 Sonera-yhtymä Oyj

30.06.1998 - 02.07.1998 Telecom Finland Yhtymä Oy

Helsinki, 17 January 2002

For a true copy of the extract:

Tuija Surojegin
Administrative Officer

Fee 91,50 euro

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**DECLARATION AND POWER OF ATTORNEY
FOR PATENT APPLICATION**

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled

**METHOD AND SYSTEM FOR THE EFFECTING PAYMENTS BY MEANS OF A MOBILE
STATION**

the specification of which has been filed under Serial No. 09/903,225 on July 11, 2001

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to the patentability of this application in accordance with Title 37, Code of Federal Regulations, Section 1.56(a).

I also acknowledge the duty to disclose information which is material to the patentability of this application in accordance with Title 37 CFR 1.63(d), which occurred between the filing date of the prior application and the filing date of the continuation-in-part application, if this is a continuation-in-part application.

I hereby claim foreign priority benefits under Title 35, United States Code, Section 119 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

Prior Foreign Application:	Country:	Finland
	Appln. No.:	990053
	Filed:	January 13, 1999

Prior Foreign Application:	Country:	PCT
	Appln. No.:	PCT/FI00/00020
	Filed:	January 12, 2000

I hereby appoint the following attorneys and/or agents to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith:

MYRON COHEN, Reg. No. 17,358; THOMAS C. PONTANI, Reg. No. 29,763; LANCE J. LIEBERMAN, Reg. No. 28,437; MARTIN B. PAVANE, Reg. No. 28,337; MICHAEL C. STUART, Reg. No. 35,698; KLAUS P. STOFFEL, Reg. No. 31,668; EDWARD WEISZ, Reg. No. 37,257; VINCENT M. FAZZARI, Reg. No. 26,879; JULIA S. KIM, Reg. No. 36,567; ALFRED FROEBRICH, Reg. No. 38,887; ALFRED H. HEMINGWAY, JR., Reg. No. 26,736; KENT H. CHENG, Reg. No. 33,849; YUNLING REN, Reg. No. 47,019; ROGER S. THOMPSON, Reg. No. 29,594; BRICE FALLER, Reg. No. 29,532; DAVID J. ROSENBLUM, Reg. No. 37,709; TONY CHEN, Reg. No. 44,607; TEODOR J. HOLMBERG, Reg. No. 50,140.

Address all telephone calls to Lance J. Lieberman, Esq. at telephone No. (212) 687-2770.

Address all correspondence to:

Lance J. Lieberman, Esq.
Cohen, Pontani, Lieberman & Pavane
551 Fifth Avenue, Suite 1210
New York, New York 10176

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon

Full Name of Sole or First Inventor: Mariette LEHTO



Inventor's signature. _____

Dated. _____
Month/Day/Year

Residence: 7 Tredegar House, 97-99 Bow Road, Bow
London E3 2AN, Great Britain
Citizenship: Finland
Post Office Address: 7 Tredegar House, 97-99 Bow Road, Bow
London E3 2AN, Great Britain

Executed on behalf of Non-Signing Inventor Mariette Lehto by the party, Sonera Oyj, having proprietary interest in the above-identified patent application:

SONERA OYJ

By  
Name: TAINA MATTINEN TAINA TUOMINEN
Title: GENERAL COUNSEL AS: GENERAL COUNSEL

Dated: 03/26/2002
Month/Day/Year

Residence Address: Pohjanpolku 3 A 11 Tuulapolku 11
FIN-02100 Espoo FIN-00330 Helsinki
Citizenship: Finland Finland
Post Office Address P.O. Box 106, FIN-00051 Sonera, Finland